

Application Serial No 10/006,733
In reply to Office Action of 17 January 2007

Attorney Docket No 83042

REMARKS / ARGUMENTS

Claims 1-9 and 11-18 are currently pending in the application. No claims have been allowed. Claims 1-9 and 11-18 are rejected.

The Examiner has rejected claims 1-9 and 11-18 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirements.

The Examiner has rejected claims 1-9 and 11-18 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The Examiner rejected claims 1-9 and 11-18 under 35 U.S.C. § 103(a) as being unpatentable over Maxwell (U.S. 6,195,643 B1) in view of Karszes (Jason Karszes & Wayne Knoblauch, "Five Points help evaluate new technology.")

These rejections are respectfully traversed in view of the remarks that follow.

Concerning the Examiner's rejection of claims 1-18 under 35 U.S.C. § 112, Applicants suggest that these steps define the invention in sufficient detail to allow one of ordinary skill in the art to practice the claimed invention. Applicants' step of collecting ideas is supported at page 10, lines 12-16 of the specification. Applicants' step of filtering is supported at page 10, line 24 through page 12, line 8. Opportunity analysis is discussed on page 12, line 9 through page 22, line 10.

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Extensive detail is provided concerning this step in order to make it more reproducible and less subjective. Committing resources is discussed on page 22, line 11 through page 26, line 21. The step of writing a business proposal is supported on page 28, line 5 through page 29, line 15. The step of submitting the proposal to the buyer is given on page 29, lines 16-25. The step of determining success is given on page 30, lines 1-9; and the step of executing the business plans is given on page 30, lines 10-14. These steps are clearly identified in the specification and fully discussed in such terms that they could be executed by one of ordinary skill in the art. Accordingly, they fully satisfy the 35 USC § 112 requirement that:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Applicants suggest that a §101 rejection does not automatically create the need for a §112 lack of enablement rejection if the invention is useful and can operate as intended without undue experimentation. Applicants suggest that just because the steps of a method require subjective decision

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making, this does not require undue experimentation or render the invention not enabled. Subjectivity is controlled in decision making processes by aggregating the subjective opinions to filter out those opinions that are outside of mainstream reasoning. Subjectivity is also controlled by establishing metrics and criteria. Applicants suggest that gathering subjective opinions in a fully systematized manner does not constitute "undue experimentation." Applicants' invention comprises a plurality of fully detailed subjective steps that when compiled give a useful, deterministic indication of a course of action. Because the end result is useful and the process is fully detailed and operative, §112 is satisfied. Applicants respectfully request withdrawal of the Examiner's §112 rejection of claims 1-9 and 11-18.

Concerning the statutory subject matter rejection, Applicants suggest that this invention is useful and provides sufficient certainty to be concrete under 35 U.S.C. §101. Concreteness as criteria was established by *In re Alappat*, 33 F.3d 1526, 31 USPQ2d 1545 (Fed.Cir. 1994). This was reiterated in *State Street Bank & Trust v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998). However, no real discussion has been made concerning the actual requirements for concreteness.

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While the Examiner has said that "the mere fact that the result is an estimate, prediction or other approximation that may not ultimately be found to be accurate is not a determinative factor for concreteness," it appears that the Examiner is using this as a determinative factor. Applicants have specified the type of data and constrained the subjective nature of the data. It is suggested that the Examiner has not considered the extent of these constraints in order specify the requirements for concreteness. While management, business and non-technological arts depend on subjective data, it appears unlikely that any invention that requires the use of subjective data would be considered statutory subject matter. Applicants suggest that this is merely a restatement of the "technological arts" form of rejection explicitly struck down in *Ex parte Lundgren*, 76 USPQ2d 1385 (Bd. Pat. App. & Int. 2005). By disallowing subjective determinations without argument, it appears that the Examiner is merely rejecting this invention because it is not in the technological arts.

Applicants' invention provides a systematized business development process. This is a "process" under the statutory subject matter categories given by § 101. Applicants suggest that the claimed process is "useful, concrete and tangible" and meets the requirements of *State Street Bank*. The process provides a business opportunity for development that has been

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analyzed as the most favorable opportunity, has been developed as a proposal, has appropriate resources committed, and has been accepted by a buyer. Applicants suggest that the business opportunity for performance is a useful result because it gives direction to the practicing business entity.

The specification of the invention has steps that are well defined to one of ordinary skill in the art, so that these steps will create a uniform result. The business opportunity for performance is forced to be more concrete by the development process. If one of ordinary skill in the art executes the steps disclosed in the specification on a plurality of business opportunities, they would most likely identify the same business opportunities as being valid. This is within the requirements that "a claim directed to estimating, predicting or approximating something does not necessarily lack concreteness."

This invention meets the tangible result requirement because execution of the business opportunity is a real world result. Out of the plurality of business opportunities, one business opportunity is executed. Execution of this business opportunity involves labor, transfer of resources and transfer of information. These are elements of a real world result.

Applicants further suggest that this method is not a law of nature, a natural phenomenon, or an abstract idea. As such, Applicants' process clearly falls within the statutory subject

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matter given by §101. Applicants respectfully request reconsideration and allowance of these claims.

First, concerning the Examiner's rejection of claims 1-9 and 11-18, Applicants suggest that Karszes is not properly prior art. Karszes has a publication date of February 2001 on its face. (Sometimes the actual publication date is much later.) Applicants conceived of the Business Development Method of the current invention in March 2000. This was followed by due diligence until actual reduction to practice in November of 2000 and patent application filing 31 October 2001. These facts are supported by the attached "Declaration of Prior Invention" and attachments. Applicants' invention predates the reference to Karszes, and for this reason, the Examiner's §103 rejections of claims 1-9 and 11-18 are improper. Applicants request reconsideration and allowance of these claims.

Concerning the Examiner's § 103 rejection of claims 1-9 and 11-18, Applicants further suggest that the submitted material does not teach each and every step of the claimed invention. Specifically, Karszes does not teach "identifying core equities of the organization." Applicants suggest that a "core equity" is a central store of value. This is the same as a "core competency". A core competency is "an area of specialized expertise that is the result of harmonizing complex streams of technology and work activity." Gary Hamel and C. K. Prahalad,

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"The Core Competence of the Corporation", *Harvard Business Review*, vol. 68, no. 3, May-June 1990, pp 79-93. This definition is confirmed by the Applicants' listing of core equities in the specification at page 11, lines 12-20. These are areas of existing expertise not future plans or goals. Karszes asks, "Does the new technology support your dairy's and your family's goals and interests?" This inquiry appears to be a forward looking statement requiring goals and a projection of desires for the future. As such Applicants respectfully suggest that neither Karszes nor Maxwell teach Applicants' step of identifying core equities of the organization. Without this step Karszes and Maxwell are unable to teach the dependent step of filtering. Claims 1-9 and 11-18 should be allowable either directly or by dependency. Applicants respectfully request reconsideration and allowance of these claims.

Specifically concerning claim 2, Applicants suggest that Maxwell does not teach the step of identifying formal announcements that are within a predetermined scope of business by a second designated point of contact. It is suggested that the primary purpose of this step is ensuring that the identified announcements are within the core equities of the organization. This is provided in the specification at page 11, lines 6-8. Because Maxwell does not conduct a core equity based review,

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this step cannot be shown. Applicants respectfully request reexamination and allowance of claim 2.

Specifically concerning the Examiner's rejection of claim 3 and dependent claims 4-9, Applicants suggest that Maxwell does not teach evaluation of an identified business opportunity because a purchase decision is much simpler than a business opportunity. Applicants cite a large number of factors that should be accounted for when evaluating a business opportunity. None of these factors is discussed in the cited prior art. Applicants suggest that this is because Applicants are applying technology and a new form of analysis to selecting a business opportunity. No one has systematized them into a process for analysis. Accordingly, Applicants respectfully request reconsideration and allowance of claims 3-9.

Concerning the Examiner's rejection of claims 11-15, Applicants suggest that Maxwell does not teach developing risk benchmarks. Maxwell at col. 6, lines 1-21 teaches establishing functional requirements. This relates to the inherent qualities of the item being purchased. This does not relate to things that represent external risks of buying the product. Risk analysis as disclosed by the Applicants on page 19, line 18 through page 21, line 2, concerns extrinsic factors that do not exist in a simple purchase decision. Again, these factors are not discussed by Maxwell because Maxwell discloses a purchase

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decision that is relatively less complex. Applicants respectfully suggest that Applicants teachings are focused on business opportunity analysis. As such, application of purchase decision prior art is inappropriate. Applicants respectfully request reconsideration and allowance of claims 10-15.


In view of the remarks above, the Applicants respectfully request reconsideration and allowance of the application.

The Examiner is invited to telephone James M. Kasischke, Attorney for Applicants, at 401-832-3653 if, in the opinion of the Examiner, such a telephone call would serve to expedite the prosecution of the subject patent application.

Respectfully submitted,
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10 April 2007

By


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